



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,488	11/05/2001	Siegfried K. Holz	2497.0020000/MBR/MWR	5623

26111 7590 01/29/2007
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
----------	--------------

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/008,488	HOLZ, SIEGFRIED K.	
	Examiner	Art Unit	
	Russell S. Glass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 2-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao, (U.S. 6,283,761).**

2. As per claims 2 and 5, Joao discloses a method of preparing and fulfilling a medication prescription written by a physician for a patient at the time of physical examination comprising the steps of:

A. providing a patient with a personal memory card (PMC) having a stored memory, wherein said stored memory includes at least the patient's personal information, consulting physician information, and a preferred pharmacy information, (Joao, col. 7, lines 16-23; col. 10, lines 61-65; col. 16, line 38-col. 17, line 24; col. 39, lines 37- col. 40, lines 12)(describing all claimed information as being stored and processed within main database, and being transferable for storage and/or processing and real-time updating to periphery P.D.A. devices and I.D. cards via wireless internet).

Art Unit: 3626

- B. reading said stored memory into a first PMC reader/writer from said PMC and viewably presenting said stored memory on a personal digital assistant (PDA), (Joao, col. 14, lines 49-58; col. 40, lines 3-12);
- C. modifying said stored memory of said PMC by a physician via entry on said PDA to include a new medication prescription to form an updated stored memory in conjunction with a physical examination of the patient by the physician, (Joao, col. 19, lines 12-20, 31-40);
- D. reading said updated stored memory of said PMC via a second PMC reader into to an office computer of the physician, said office computer programmed to electronically transfer said updated stored memory to a central host server, (Joao, fig. 2, col. 15, line 59-col. 16, line 18; col. 19, lines 12-20, 31-40; col. 40, lines 3-12)(reference discloses that all system components can have card reader/writers);
- E. transferring said updated stored memory to the host server via the Internet, (Joao, col. 15, lines 18-46);
- F. transmitting a prescription fulfillment request electronically by said host server for the new medication prescription contained within said updated stored memory to the preferred pharmacies, said host server configured for electronically transmitting said request, (Joao, fig. 2; col. 12, line 58- col. 13, line 7; col. 16, lines 19-32)(disclosing that a pharmacist is a form of provider);
- G. transmitting a confirmation electronically from one of the pharmacies selected in step F back to said office computer advising that any new prescriptions are fulfilled, (Joao, col. 31, line 66-col. 32, line 45)(notification is considered to be conformation).

Art Unit: 3626

H. electronically transmitting information regarding the examination and the new medication prescription to the patient's insurer, (Joao, col. 36, line 66-col. 37, line 21).

3. As per claims 3, 4, 6, and 7 these system claims contain essentially the same limitations as corresponding method claims 2 and 5 and are therefore rejected on the same basis as claims 2 and 5. The citations applied against method claims 2 and 5 are hereby incorporated against claims 3, 4, 6 and 7 by reference.

Furthermore, system claims 3, 4, 6 and 7 contain non-functional descriptive material that fails to further limit the disclosed systems. For example, see claim 3 stating: "data stored on the stored memory, said data including the patient's personal information, consulting physician information, and preferred pharmacy information". The claimed information stored on the modifiable stored memory fails to further limit the claimed system because when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. System claims 4, 6 and 7 are replete with similar non-functional limitations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Mayaud, (U.S. 5,845,255); Mayaud, (U.S.

Art Unit: 3626

2003/0144884); Mayaud, (U.S. 2005/0060197); Edelson et al., (U.S. 5,737,539); Morey, (2005/0182656).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSG
1/18/2007

256


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600